

§102 Rejection of the Claims

Claims 1, 3, 11 and 13 were rejected under 35 USC § 102(b) as being anticipated by Hageman (US 5,362,044).

Applicant has amended claim 1 to better describe the subject matter recited in the claim. Applicant submits that claim 1 is not anticipated by the Hageman reference, since the cited reference does not include each limitation recited in the claim. For instance, a golf cup apparatus which includes a golf cup and a cup sleeve disposed within the golf cup, "the sleeve comprising a one-piece, seamless cylinder having an open circular top end and an open circular bottom end," as recited in claim 1.

In contrast, Hageman teaches away from such subject matter by discussing a flat sheet which is formed into a cylinder shape when inserted into the cup, but is a flat strip when it is made and shipped. Hageman discusses that "[t]his orientation provides for maximum ease of printing or painting of the advertising message, minimum requirements of storage space for the replacement inserts, and maximum ease of shipping." (Col. 4, lines 5-8). However, in use, Hageman's insert leaves a seam along the edge of the insert when the flat sheet is inserted into the cup. Such a design can result in the insert become torn or damaged because of the seam. For instance, golfer's may catch their hands on the seam while reaching into the cup, or the flag may snag along the seam. The seam is also an area which can peel away and collect dirt. In contrast, the present claim recites a sleeve comprising a one-piece, seamless cylinder. This results in a relatively smooth interior surface for the golf cup, which helps solve the problems of the Hageman insert.

Dependent claims 3, 11, and 13 include all the limitations of parent claim 1 and are therefore also not anticipated by the Hageman reference. Reconsideration and allowance are respectfully requested.

Claims 8, 22, 24, 25, 27, 28 and 29 were rejected under 35 USC § 102(b) as being anticipated by Crocker (UK 355171).

Claim 8

Claim 8 includes all the limitations of its parent claim 1. Applicant submits that claim 8 is not

anticipated by the Crocker reference since the reference does not include each limitation recited in the claim. For instance, a golf cup apparatus which includes a golf cup and a cup sleeve disposed within the golf cup, "the sleeve comprising a one-piece, seamless cylinder having an open circular top end and an open circular bottom end," as recited in parent claim 1. In contrast, Crocker teaches a sheet (i.e. a broad, thin, usually rectangular piece of material) of fibrous material folded into a cylinder. (Page 1 lines 84-86). As can best be seen in the top view of Figure 3 of Crocker, the folded sheet of Crocker results in an overlapped edge of the folded sheet. This results in a seam which can be seen at approximately 10 o'clock in Figure 3. As noted above, such a seam is an area which can peel away, get snagged by a golfer's hand or the flag, and can collect dirt. In contrast, the one-piece, seamless cylinder sleeve of the present claim can help solve these problems. Reconsideration and allowance is respectfully requested.

Claims 22 and 24

Applicant traverses the rejection of claim 22. Anticipation requires that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131. Here, the cited reference does not include each limitation recited in the claim. For instance, a golf cup sleeve which includes a cylindrical sleeve having "a one-piece, seamless form wherein the cylindrical sleeve presents a substantially smooth inner surface when the cylindrical sleeve is mounted within the golf cup." As discussed above, Crocker clearly shows in Figure 3 that his sleeve is a sheet of folded paper which results in a seam along the side of the insert when it is within the cup.

Claim 24 includes all the limitations of parent claim 22 and is therefore also not anticipated by the Crocker reference. Moreover, Applicant cannot find in Crocker a "notch in an upper edge of the sleeve," as recited in claim 24. Reconsideration and allowance is respectfully requested.

Claims 25, 27, and 28

Applicant traverses the rejection of claim 25. Here again, the cited reference does not include each limitation recited in the claim. For instance, a golf cup apparatus which includes a golf cup and a golf cup sleeve, wherein the golf cup sleeve includes “an unbroken cylindrical sleeve having an outer diameter dimensioned to fit against the inner surface of the golf cup.” As discussed above, Crocker clearly shows in Figure 3 that his sleeve is a sheet of folded paper which results in a broken section including a seam along the side of the insert when it is within the cup.

Claim 27 and 28 include each limitation of parent claim 25 and are therefore also not anticipated by the Crocker reference. Reconsideration and allowance is respectfully requested.

Claim 29

Applicant has amended claim 29 to better describe the subject matter of the claim. Applicant believes claim 29 is not anticipated by the Crocker reference since the reference does not discuss each limitation of the claim. For instance, “placing a one-piece, seamless cylindrical golf cup sleeve into a golf cup.” The discussion above for claim 22 is incorporated herein by reference. Reconsideration and allowance is respectfully requested.

§103 Rejection of the Claims

Claims 9, 12 and 20 were rejected under 35 USC § 103(a) as being unpatentable over Hageman.

Claims 9 and 12

Claims 9 and 12 include each limitation of amended parent claim 1. Applicant submits that the claims are not obvious in view of Hageman since the Hageman reference does not discuss or suggest each limitation of parent claim 1. In fact, as discussed above, the Hageman reference teaches away from the subject matter of a “sleeve comprising a one-piece, seamless cylinder having an open circular top end and an open circular bottom end,” as recited in parent claim 1. As discussed above, Hageman

discusses a flat sheet which is formed into a cylinder shape when inserted into the cup, but is a flat strip when it is made and shipped. Hageman discusses that “[t]his orientation provides for maximum ease of printing or painting of the advertising message, minimum requirements of storage space for the replacement inserts, and maximum ease of shipping.” (Col. 4, lines 5-8). Accordingly, modifying the Hageman reference would defeat the intended purpose of the reference which is to provide an easily printed and easily shipped flat sheet. It is settled law that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01.

Claim 20

Applicant has amended claim 20 to better describe the subject matter of the claim. Applicant believes claim 20 is not obvious over the cited reference since the reference does not discuss or suggest each limitation of the claim. For instance, a cup sleeve comprising “a one-piece, seamless plastic cylinder.” The discussion above for claims 1 and 9 is incorporated herein by reference. Reconsideration and allowance is respectfully requested.

Claims 23, 26 and 30 were rejected under 35 USC § 103(a) as being unpatentable Crocker in view of Hageman.

Claim 23

Applicant traverses the obviousness rejection since, even if combined, the combination does not include or suggest each limitation of parent claim 22. For instance, “the cylindrical sleeve having a one-piece, seamless form wherein the cylindrical sleeve presents a substantially smooth inner surface when the cylindrical sleeve is mounted within the golf cup,” as recited in parent claim 22. The discussion above for claim 22 is incorporated herein by reference. Moreover, Applicant traverses the assertion that there is a motivation to modify the Crocker reference to have “a top edge adapted to be matingly fitted against a lip extending from an inner surface of the golf cup.” Crocker teaches away from such a

mounting technique. The stated purpose of the Crocker reference is “prevent enlargement of the hole by the caving in of the soil around its top.” (Page 1, lines 69-71). Thus Crocker discusses a top portion d² which extends above the cup. It would destroy the purpose of Crocker to be modified so the top edge of his insert was fitted against a lip extending from an inner surface of the golf cup, as claimed. Reconsideration and allowance is respectfully requested.

Claim 26

Applicant traverses the obviousness rejection since, even if combined, the combination does not include or suggest each limitation of parent claim 25. For instance, a “golf cup sleeve includes an unbroken cylindrical sleeve having an outer diameter dimensioned to fit against the inner surface of the golf cup,” as recited in parent claim 25. The discussion above for claim 25 is incorporated herein by reference. Also, as discussed above, there is no motivation to modify the Crocker reference to include the subject matter of claim 26, and the discussion for claim 23 is incorporated herein by reference. Reconsideration and allowance is respectfully requested.

Claim 30

Applicant traverses the obviousness rejection since, even if combined, the combination does not include or suggest each limitation of parent claim 29. For instance, “placing a one-piece, seamless cylindrical golf cup sleeve into a golf cup,” as recited in parent claim 29. The discussion above for claim 29 is incorporated herein by reference. Also, as discussed above, there is no motivation to modify the Crocker reference to include the subject matter of claim 30, and the discussion for claim 23 is incorporated herein by reference. Reconsideration and allowance is respectfully requested.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
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TECHNOLOGY CENTER ROOM

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-359-3267) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 25 day of June, 2002.

Candis B. Buending

Name

Signature

A handwritten signature in dark ink, appearing to read "Candis B. Buending", written over a horizontal line.